REMARKS/ARGUMENTS

Claims 1-8, 12, 35-37, 40-44, 53, and 54 are pending in the application. Claims 9-11, 13-34, 38-39, and 45-52 have previously been canceled without prejudice or disclaimer.

All pending claims stand rejected as lacking novelty or as obvious. Applicant traverses the grounds for these rejections and incorporates by reference in its entirety the Response filed on December 30, 2004.

I. OVERVIEW

The pending claims are directed to subject matter encompassing, among other things, systems and methods for planning energy supply for energy consumers by negotiating an energy supply specification with one or more energy suppliers. As discussed in the Response filed on December 30, 2004, the rejection of the pending claims over U.S. Patent No. 6,598,029 to Johnson ("Johnson") is in error because the "negotiation of an energy supply specification" involves claim terminology which, properly construed, is not neither disclosed nor suggested by that reference.

All of the pending claims involve, in one way or another, the *negotiation* of an energy supply specification. The alleged prior art cited against the pending application, by contrast, does not disclose or suggest the negotiation of an energy supply specification. Applicant has explained how "auction" is the antithesis of "negotiation." (Amendment of December 30, 2004).

Moreover, under recent controlling legal precedent, Applicant's definition of "negotiation" as relating to "arranging or bringing about through exchange of information and compromise" should be found by a court of competent jurisdiction to govern the construction of this claim term. The Examiner, in dismissing Applicant's argument, now relies on a definition of negotiation extracted from the American Heritage Dictionary, Fourth Edition, as differing from the definition Applicant discussed in the December 30, 2004 response. Since the Office Action was issued, however, the U.S. Court of Appeals for the Federal Circuit has removed any doubt that the specification is to be accorded especially significant weight when construing patent

claim terms, *Phillips* v. *AWH Corp.*, No. 03-1269, -1286, Slip Op. at 13-16 (Fed. Cir. July 12, 2005), and that the specification should govern in instances where special definitions are provided (id. at 16). In the present case, although Applicant does not contend that the specification provides a special definition for the word "negotiate" giving it a meaning different than it would otherwise possess, under *Phillips* the definition in the specification must prevail over a dictionary definition to the extent the two sources of meaning are inconsistent. Applicant's definition of negotiation as relating to "arranging or bringing about through exchange of information and compromise" should therefore be found by a court of competent jurisdiction to govern the construction of this claim term, rather than the definition proffered and applied by the Examiner.

The Examiner also opines that Johnson allows bidders to "adjust" their auction bids, which the Examiner "interprets as a form of negotiation." Applicant respectfully submits that it is the claims terms – namely "negotiation" – that are to be interpreted, not the language in an applied reference. Applicant has explained above the appropriate construction of "negotiation." The cited passages of the Johnson reference, relied on at page 8 of the Office Action in rejecting the present claims, fall short of that definition. Johnson relates to auctions, as the Examiner must acknowledge. Negotiation and auction, as explained in the Response of December 30, 2005, are antithetical to one another. As also discussed in that Response, an auction involves parties placing bids in a manner that obviates negotiation. Auctions set prices in the absence of negotiation. None of these assertions about claim terminology or about the disclosure of Johnson as a whole, have been gainsaid. Johnson used the term "negotiate," but not in the context of energy supply specifications. Had Johnson intended that "auction" somehow disclose "negotiate" (despite its plain meaning to the contrary), it could have defined it as such. Yet it failed to do so.

II. CLAIMS 1, 35, 36 AND DEPENDENCIES

Claims 1, 35 recite, among other limitations, the "an interface for...negotiation of a supply specification from said at least one energy supplier to said energy consumers." Johnson does not disclose this limitation, but very much the opposite: An auction in which entities place

bids to a moderator. The passage from Johnson relied on in rejecting the claims (column 9, line 44-column 10, line 5) does not disclose or suggest the recited interface feature, which is designed to permit the conduct of negotiations and to do so between the claimed subsystems over the network.

Because Johnson does not identically disclose each and every limitation of claims, the Patent and Trademark Office has failed to carry its burden under 35 U.S.C. Sec. 102(e). Applicant therefore respectfully submits that claims 1, 35, and 36, and the claims which depend from them, are patentable over the art of record.

III. CLAIMS 40 AND 42

Claim 40 recites, among other limitations, that an energy planning system comprises a communication interface to energy suppliers, a processor coupled to the communication interface, a first routine executed by the processor for exchanging energy planning information through the communication interface, and a second routine executed by the processor for negotiating an energy supply specification from the energy suppliers to the energy consumers. Claim 42 recites analogous limitations.

Johnson, Applicant respectfully submits, fails to identically disclose these limitations. The PTO has relied on col. 11, lines 16-32 and col. 25, lines 35-60 as disclosing these limitations. The first of these passages at most appears to relate to transmission of bids by energy providers to the moderator being made by a data link or network. The second of these cited passages refers to the Moderator having a computer with a processor and memory to communicate the Providers' energy management computers. Assuming without conceding these characterizations to be accurate, they do not disclose the recited claim limitations. No mention is made of *a first routine for exchanging energy planning information* through a communication interface. Even more importantly, a third cited passage, col. 9, line 44 through col. 10, line 5, does not disclose a second routine executed by the processor for *negotiating an energy supply specification* from energy suppliers to energy consumers. That passage, as discussed above, does not disclose "negotiating," as that term is properly construed. Moreover, the passage fails to disclose the recited structure, namely a second routine of the energy planning system executed

by the processor for negotiating an energy supply specification from energy suppliers to energy consumers., recited in the claims.

For these reasons, Applicant respectfully submits that independent claims 40 and 42, and the claims which depend from them, are in condition for allowance.

IV. CLAIMS 44 AND 53

Claim 44 recites, among other limitations, a step of negotiating an energy supply specification responsive to requests for energy and from at least one energy supplier. Claim 53 also recites, among other limitations, the step of employing a global communications network to negotiate an energy supply specification from at least one energy supplier and responsive to requests for energy. As discussed in the Overview of Section II, above, the Johnson reference does not disclose or suggest "negotiation" of an energy supply contract, as that term is properly construed.

For this reason, claims 44 and 53, and the claims which depend from them, are not anticipated by Johnson. Withdrawal of this rejection is therefore respectfully requested.

V. REJECTIONS UNDER 35 U.S.C. § 103(A)

Claims 2 and 37 stand rejected over Johnson as applied in view of Robinson et al., Development of the Intercontrol Center Communications Protocol, specifically described by the Applicant in the Background Section of the application. See, e.g., Application, page 3, line 3 – page 5, line 2.

Claim 2 depends from independent claim 1, and claim 37 from independent claim 36. Both incorporate the limitations of the respective base claims, 35 U.S.C. §112, ¶4, the rejections of which are traversed above. For the same reasons, as advanced in Sections I and II above, claims 2 and 37 are respectfully submitted to recite patentable subject matter.

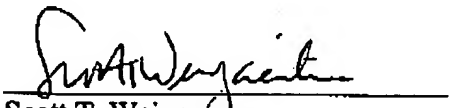
IV. CONCLUSION

Upon entry of this Preliminary Amendment, claims 1-8, 12, 35-37, 40-44, 53 and 54 are pending in the application. Applicant submits that the claims, for the reasons set forth above, are now in condition for allowance. Reconsideration and allowance are therefore respectfully requested.

Other than as specified in the first paragraph of this communication, no fee is believed to be due in connection with this communication. However, if such additional fee is required, the Commissioner is authorized to charge the fee to Deposit Account No. 23-1703.

Dated: September 19, 2005

Respectfully submitted,



Scott T. Weingaertner
Reg. No. 37,756
Attorney for Applicant

Customer No. 007470
White & Case LLP
Direct Line: (212) 819-8404